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18 SEP 2007

In re Application of	:	
Barney et al.	:	
Application No.: 10/574,386	:	DECISION
PCT No.: PCT/US04/32160	:	
Int. Filing Date: 02 October 2004	:	ON
Priority Date: 02 October 2003	:	
Attorney Docket No.: TEVA33001	:	PETITION
For: Dry Powder Inhalation Apparatus	:	

This is in response to the petition under 37 CFR 1.47(a) filed on 02 May 2007.

### **BACKGROUND**

This international application was filed on 02 October 2004, claimed an earlier priority date of 02 October 2003, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 02 April 2006. Applicants filed *inter alia* the basic national fee on 31 March 2006.

On 02 October 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration compliant with 37 CFR 1.497(a) and (b).

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), the \$200.00 petition fee is being charged to petitioner's Deposit Account 12-1095, per the authorization appearing in the instant petition.

As to requirement (2) as it pertains to David O'Leary, petitioner presents an "Affidavit of Samantha Claire Radley" (and attached documentation). Ms. Radley refers to DHL parcels sent to Mr. O'Leary on 03 August 2006 and 05 January 2007 as having been returned as undeliverable, but no documentation on this point (such as copies of tracking reports or of the returned envelopes) has been provided. Ms. Radley also refers to internet searches made using the 192.com and "The Phone Book" services. However, it is not clear why these inquiries were limited to the locality of "Grays," especially in view of Ms. Radley's characterization that such a search should have been successful "if a person was resident in the United Kingdom" and not merely in Grays. In addition, it is not clear why Ms. Radley did not search the BT.com site in the case of Mr. O'Leary, though she states she used it in connection with Ms. Striebig.

With regard to Ms. Striebig, Ms. Radley states that correspondence sent to her on 03 August 2007 was returned, and references a "DHL courier bag" as evidence, but no such evidence accompanies the petition. Thus, it is not clear that the parcel was actually returned. Moreover, the copy of the letter dated 03 August 2007 does not specifically refer to the instant application number (merely referencing "PCT/2004/032160," which omits the identification of the receiving Office). Therefore, it is also not clear whether petitioner specifically sought her execution of a declaration in this specific application, at her indicated last known address.

Ms. Radley further indicates that an alternative possible address ("Cyna Court") for Ms. Striebig was identified as the result of an internet search, and that correspondence sent to said address on 23 August 2006, 02 November 2006 and 05 January 2007 was not successfully delivered. In paragraph 5 of her "affidavit" regarding Ms. Striebig, Ms. Radley references a returned DHL package bearing allegedly illegible markings, but no copy of this writing has been provided. Such evidence is potentially highly probative of the issue of whether Ms. Striebig has in fact moved from her "last known" address to the Cyna Court address which appears to have become the focus of petitioner's efforts (if this becomes established, petitioner will be required to update the statement of Ms. Striebig's last known address). Based on the totality of the evidence presented, it would not be appropriate to conclude that Mr. O'Leary and/or Ms. Striebig have been shown to be unavailable within the meaning of 37 CFR 1.47(a).

Regarding requirement (3), the petition includes a statement of the last known addresses of David O'Leary and Rachel Striebig.

Regarding requirement (4), the declaration filed on 02 May 2007 appears to have been compiled using sheets from several incomplete declaration documents. MPEP 201.03 states in part that

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

In the instant case, it is not clear whether Brian Barney signed a complete copy of the declaration document, nor whether counsel attempted to present each of David O'Leary and Rachel Striebig with a complete declaration. Rather, it appears as though the declaration pages appearing on pp. 10-17 of the instant correspondence were intended as a copy of the declaration allegedly sent to David O'Leary, while the single declaration page appearing on p. 61 appears to have been intended as a copy of the declaration sent to Rachel Striebig. Clarification is required.

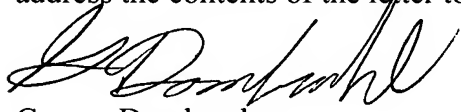
### **DECISION**

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional

petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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